



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,940	06/23/2003	Robert E. Sosnowski	1107-3 DIV	7862
7590	04/07/2006			
Gerald T. Bodner Bodner & O'Rourke, LLP 425 Broadhollow Road, Suite 108 Melville, NY 11747			EXAMINER COTTON, ABIGAIL MANDA	
			ART UNIT 1617	PAPER NUMBER

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/601,940	Applicant(s) SOSNOWSKI ET AL.	
	Examiner Abigail M. Cotton	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/23/03, 10/8/03, 11/23/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 7-12, drawn to methods of reducing the risk or progression of cardiovascular disease comprising administering a composition comprising dextromethorphan, folic acid or folate, vitamin B6 and vitamin B12, classified in class 514, subclasses 185, 249, 289, for example.
- II. Claims 13-16, drawn to a composition for reducing the risk or progression of glaucoma comprising dextromethorphan, folic acid or folate, vitamin B6, vitamin B12, bilberry, bioflavonoids and beta-carotene, classified in class 514, subclasses 185, 249, 289, for example.
- III. Claims 17-19, drawn to a method for reducing the risk or progression of glaucoma comprising administering a composition comprising dextromethorphan, folic acid or folate, vitamin B6, vitamin B12, bilberry, bioflavonoids and beta-carotene, classified in class 514, subclasses 185, 249, 289, for example.
- IV. Claims 20-24, drawn to a composition for reducing the risk or progression of tardive dyskinesia comprising dextromethorphan, folic acid or folate, vitamin B6, vitamin B12, lecithin, an antioxidant and oligomeric proanthocyanidins, classified in class 514, subclasses 185, 249, 289, for example.

- V. Claims 25- 29, drawn to a method for reducing the risk or progression of tardive dyskinesia disease comprising administering a composition comprising dextromethorphan, folic acid or folate, vitamin B6, vitamin B12, lecithin, an antioxidant and oligomeric proanthocyanidins, classified in class 514, subclasses 185, 249, 289, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions II, IV and I, III, V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the risk or progression of cardiovascular disease can be reduced by using a materially different product, such as aspirin, statins, HMG CoA reductase inhibitors, etc. Also the risk or progression of glaucoma can be reduced by using a materially different product, e.g. beta blocker eye drops. The risk or progression of tardive dyskinesia can also be reduced using a materially different product, e.g. bromocriptin.

Because these inventions are distinct for the reasons given above and the search required for Groups I, III and V is not required for Groups II and IVI, restriction for examination purposes as indicated is proper. It is noted that while the searches of

Art Unit: 1617

the Groups may be overlapping, there is no reason to believe that the searches would be co-extensive. In searching Groups II and IV, the Examiner will be focusing on the patentability of the product itself, and not the process of using of Groups I, III and V. Conversely, in searching Groups I, III and V, the Examiner will be focusing on the patentability of the process and not the product itself. Accordingly, a search for both groups would pose an undue burden on the Office.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effect (MPEP 806.04, MPEP 808.01.) In the instant case the different inventions have different modes of operation, such as in the treatment of tardive dyskinesia vs. glaucoma, etc.

Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper. It is noted that while the searches of Groups II and IV may be overlapping, there is no reason to believe that the searches would be co-extensive. In searching Group II, the Examiner will be focusing on the composition suitable for treatment of glaucoma, and not the composition for treatment of tardive dyskinesia of Group IV. Conversely, in searching Group IV, the Examiner will be focusing on the patentability of composition for treating tardive dyskinesia, and not the composition for treatment of glaucoma as in Group II. Accordingly, a search for both groups would pose an undue burden on the Office.

Inventions I, III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effect (MPEP 806.04, MPEP 808.01.) In the instant case the different inventions have different functions, such as in the treatment of tardive dyskinesia vs. glaucoma, etc.

Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is proper. It is noted that while the searches of Groups I, III and V may be overlapping, there is no reason to believe that the searches would be co-extensive. For example, in searching Group I, the Examiner will be focusing on the method of treatment of cardiovascular disease, and not the method of treatment of tardive dyskinesia of Group V. Conversely, in searching Group V, the Examiner will be focusing on the patentability of treating tardive dyskinesia according to the method, and not the method of treatment of glaucoma as in Group III. Accordingly, a search for all groups would pose an undue burden on the Office.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or**

otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Due to the complicated nature of the restriction, the restriction requirement is being made via written correspondence in lieu of a telephone interview.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMC


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER